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REMARKS

Applicant has carefully studied the Office Action of September 22, 2003 and offers the following remarks in response thereto.

Initially, Applicant appreciates the indication that claim 6 contains allowable subject matter, but does not believe that an amendment is required at this time because the underlying independent claim defines over the rejection of record.

IDS

Applicant has reviewed paragraph 3 of the Office Action that deals with the IDS and particularly indicates that the foreign references have not been considered because Applicant has not included a concise explanation of the relevance as it is presently understood by the individual designated in 37 C.F.R. § 1.56(c). Applicant is not in possession of a full translation of any of these documents, and Applicant's knowledge of their relevance is limited to what is stated within the abstract. Applicant submitted these references in the interests of full disclosure and believes that Applicant has satisfied its burden under the duty of disclosure. Applicant further points the Patent Office to MPEP § 609(III)(A)(3)¹ which states "submission of an English language abstract of a reference may fulfill the requirement for a concise explanation." While Applicant appreciates the Patent Office's statement that "substantial matter is frequently disclosed outside the context of the abstract yet omitted from the abstract . . ." Applicant is unable to provide, without incurring the expense of a translation, any additional insight into the references.

Summary of the Invention

Before addressing the rejections of record, Applicant provides a brief summary of the invention so that the remarks are provided in their proper context. The present invention is a system that joins a cash transaction apparatus with a transponder system during a fueling transaction. Specifically, the present invention is designed to allow a customer to use cash to pay for a fueling transaction while concurrently wirelessly providing identification indicia to the control system through a remote communications unit. This identification indicia is then linked to the customer related information that is generated by the control system. The customer related information may be any number of things, but in a particularly claimed embodiment is a value of

¹ Page 600-122, August 2001 edition of the MPEP.

change that is due to the customer after the fueling transaction. This change is then stored so that the customer may use this change in a future transaction. In this manner, the fuel dispenser does not have to have a cash distributor or coin dispenser, but can accept cash payments from the customer.

The references of record do not provide the link between paying for a fueling transaction with cash and receiving some form of customer related information in exchange therefore. While the Patent Office points to various locations in the references, there quite simply is no suggestion that the cash transaction corresponding to the fueling transaction can link to identification indicia provided from the customer's remote communications device.

§ 103

Claims 4, 10-14, 26-28, 39, and 44-46 were rejected under 35 U.S.C. § 103 as being unpatentable over Gunnarsson '919 in view of Ramsey. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where in the combination of references each and every claim element is shown or suggested. MPEP § 2143.03. Further, the Patent Office must articulate some reason for combining the references. If the combination of references does not teach all of the claim elements, there must be some objectively supported reason to modify the combination. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). In the present case, the combination of references does not show all of the claim elements, and the Patent Office has not articulated a reason to modify the combination. Since the combination does not show all of the claim elements and there is no reason to modify the combination, the Patent Office has not established *prima facie* obviousness.

Gunnarsson is directed to a situation wherein the fuel customer pays for fuel with a transponder. The transponder may act like a debit card, but in and of itself, the transponder is not cash. In fact, Gunnarsson stresses the importance of not requiring a customer to exit the vehicle (see page 1, lines 19-24) such as is required when a cash transaction takes place. The instances that a cash transaction are mentioned by the reference are in the context of a customer using cash to "recharge" or "filling a new amount into the transponder" such as is discussed at page 6, lines 18-24. Such cash transactions do not correspond to fueling transactions.

Ramsey is directed to a fuel dispenser that accepts credit cards and accepts cash. When a cash transaction occurs, the fuel dispenser can dispense change to the customer. Ramsey deals

with the two systems separately and provides no indication that the two systems can be used concurrently in a single fueling transaction. For example, the credit card process is discussed at page 8, lines 1-17, and the cash process is discussed at page 8, line 18 through page 9, line 15. There is no overlap between the processes.

Neither reference teaches or suggests that the cash transaction indicator signals the control system that there is a cash transaction corresponding to the fueling transaction and that the control system creates customer related information and associates the customer related information with the identification indicia when the cash transaction indicator has sent the signal that there is a cash transaction corresponding to the fueling transaction. Note that this element is present in each of the independent claims pending in the present application. Since the references individually do not teach or suggest this claim element, the combination of references cannot teach or suggest the claim element. Since the combination of references does not teach or suggest the claim element, the Patent Office has not established *prima facie* obviousness and the claims define over the rejection of record.

Applicant further objects to the combination of Gunnarsson with Ramsey. The Patent Office is obligated to provide objective evidence of why a combination of references is desirable. The Patent Office, in support of the motivation to combine the references, alleges that the combination is motivated to have the dispenser controller determine change premised upon overpayment because cash purchasers may either be unable to fill their vehicle to the amount paid or customers may not have small enough bills to purchase small quantities of fuel. This position ignores the teachings of Gunnarsson that indicate that there should be no cash fueling transactions. The whole point of Gunnarsson's disclosure is to eliminate the need to provide change during a fueling transaction and thus, there would be no motivation within Gunnarsson to combine the references, and Gunnarsson teaches away from such a combination.

Even if the combination is proper, the combination does not result in the claimed invention. If the references are combined, the resulting system is a system that has three payment mechanisms which have no communication therebetween. Specifically, the first payment mechanism is the credit card reader of Ramsey. As explained above, this credit card mechanism is self-contained and does not communicate with any other payment mechanism. The second mechanism is the cash acceptor and change dispenser of Ramsey. Again, this mechanism is self-contained and does not communicate with any other payment mechanism.

The final mechanism is the transponder system of Gunnarsson which would not require the customer to exit the vehicle. Again, nothing in this mechanism necessarily communicates with the other payment mechanisms. Thus, the combination does not result in the claimed invention. Only by modifying the combination is the claimed invention shown, and the Patent Office has offered no objective evidence of any reason to modify the combination. Since the Patent Office has not offered any objective evidence to modify the combination such that the customer who pays with cash for a fueling transaction has customer information created in the control system and associated with the identification indicia provided by the remote communications unit, the Patent Office has not established *prima facie* obviousness, and the claims define over the references of record.

Claims 4, 10-14, 26-28, 39, and 44-46 were rejected under 35 U.S.C. § 103 as being unpatentable over Gunnarsson '919 in view of Bohnert et al. Applicant respectfully traverses. The standard for obviousness is set forth above. Likewise, Applicant has provided an analysis of Gunnarsson above.

The Patent Office effectively admits that Gunnarsson does not show the cash transaction corresponding to the fueling transaction. The Patent Office relies on Bohnert et al. to disclose this element. However, this combination is improper. The Patent Office must consider a reference for all that it teaches including those portions that teach away from a proposed combination. MPEP § 2141.03. The Patent Office is, in this case, ignoring those portions of Gunnarsson which teach away from the combination. Specifically, Gunnarsson emphasizes the need to eliminate cash transactions and eliminate the need for people to exit the vehicle (page 1, lines 19-24). In this case, the teachings in Gunnarsson that describe a desire to eliminate cash transactions teach away from a combination with a device that promotes cash transactions (such as Bohnert et al.'s terminal). In light of these teachings, the combination of the references is improper. Since the combination of references is improper and Gunnarsson by itself does not teach or suggest all of the claim elements, the Patent Office has not established *prima facie* obviousness.

Even if the combination is proper, the combination does not result in the claimed invention. Specifically, if Gunnarsson is combined with Bohnert et al., the combination would result in a first payment mechanism that relied on transponders and would not require the customer to exit the vehicle. The combination would further have a second payment mechanism

in the form of the cash acceptor/card reader of Bohnert et al. Nothing in the straight combination of the references indicates that any sort of communication would exist to the transponder in the event of a cash payment. The only time the transponder would interact with the cash acceptor would be in those instances when the transponder was being "refilled" or "charged." To this extent, the combination of references does not teach or suggest the claimed invention which requires that the customer related information is associated with the identification indicia received from the remote communications unit in response to a cash transaction being indicated.

To arrive at the claimed invention from a straight combination of the references, the Patent Office is required to provide objective evidence of a motivation to modify the combination. *In re Dembiczak*. None of the motivations offered on page 4 of the Office Action necessitate the modification to the combination. To this extent, there is no motivation to modify the combination to arrive at the claimed invention. Since there is no motivation to modify the combination to arrive at the claimed invention, the claimed invention defines over the rejection of record, and the claims are in a condition for allowance.

Applicant requests reconsideration of the rejections. The combinations of record are improper, and if they are not improper still do not show all the claim elements. Since the combinations do not show the claim elements, the claims are in a condition for allowance. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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